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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/516,493 03/01/00 CHARRON

M 96700/613

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HM22/1003

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EXAMINER

KAUSHAL, S

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/516,493

Applicant(s)

CHARRON ET AL.

Examiner

Sumesh kaushal

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, 19-21 and 25-29, drawn to isolated nucleic acid encoding GLUTx, classified in class 536, subclass 23.1.
- II. Claims 17-18, drawn to a purified GLUTx protein or an analog thereof, classified in class 530, subclass 350.
- III. Claims 22-24, drawn to an agent that binds to the GLUTx protein, wherein the agent is an ANTIBODY, classified in class 530, subclass 387.1.
- IV. Claims 22-24, drawn to an agent that binds to the GLUTx protein, wherein the agent is a PEPTIDE OR PROTEIN, classified in class 530, subclass 300 or 350.
- V. Claims 22-24, drawn to an agent that binds to the GLUTx protein, wherein the agent is a NUCLEIC ACID (transcriptional factor), classified in class 536, subclass 24.1.
- VI. Claims 22-24, drawn to an agent that binds to the GLUTx protein, wherein the agent is a DRUG, classified in class 514, subclass 2.
- VII. Claims 22-24, drawn to an agent that binds to the GLUTx protein, wherein the agent is an ANTISENSE NUCLEIC ACID, classified in class 536 subclass 24.5.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I (nucleic acid) and II (proteins) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP, 806.05(f)). In the instant case the polypeptide can be isolated from cells endogenously expressing the polypeptide, rather than by recombinant means. Thus, these inventions are mutually exclusive and are of separate use.

Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP, 806.04, MPEP, 808.01). Furthermore, inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP, 806.05(h)).

In the instant case inventions of Groups III, IV, V, VI and VII are drawn to an Antibody, a Protein, Nucleic acid, a Drug that binds to GLUTx protein and an Antisense nucleic acid sequence, which have different modes of operation, functions and effects. These inventions are distinct because product as claimed can be used in a materially different process of using that product. For example, an antibody can be used to detect the expression of GLUTx protein on a cell, whereas Nucleic acid that binds to GLUTx is a transcription factor that regulates the transcription of a protein by GLUTx protein. Drugs are synthetic chemical molecules, which have distinct therapeutic effects. Furthermore, an antisense nucleic acid molecule is distinct from an antibody, protein or Nucleic acid that binds to GLUTx due to its structure and function. Therefore inventions related to these compounds are distinct and are of separate uses.

In addition, the inventions of Group I-II are distinct from inventions of Group III-VII. GLUTx nucleic acid sequences or protein are distinct from the agents that bind to GLUTx protein because they have different structure and different modes of operation, functions and effects (*supra*). Thus these inventions are distinct and are of separate uses.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.


Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Deborah Clark can be reached on (703) 305-4051. The fax-phone number for the organization where this application or proceeding is assigned as (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst Tracey Johnson, whose telephone number is (703) 308-0377. If the claims are amended canceled and/or added the applicants are required to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>) and A CLEAN COPY OF ALL PENDING CLAIMS IS REQUESTED to facilitate further examination.

SUMESH KAUSHAL
PATENT EXAMINER


SUMESH KAUSHAL
PATENT EXAMINER